

REMARKS

Claims 1-11 and 13-24 were pending in this application. Claims 1-11 and 13-24 were rejected. By virtue of this response, claims 1, 5, 7 and 23 are amended, and claims 13-18 were cancelled. Accordingly, claims 1-11 and 19-24 are now under consideration.

Support for amended claims 1, 5, 7 and 23 can be found throughout the original application. Claims 1, 7 and 23 were amended to clarify the claims, and claim 5 was amended to delete the term “derivative”. Support for the amendments in claim 23 can be found throughout the original specification, and *inter alia*, at page 32, lines 25-29 and page 36, line 17- page 37, line 26. No new matter has been added and entry of the amendments is respectfully requested.

The amendments are made solely to promote prosecution without prejudice or disclaimer of any previously claimed subject matter. With respect to all amended and cancelled claims, Applicants have not dedicated or abandoned any unclaimed subject matter and moreover have not acquiesced to any rejections and/or objections made by the Patent Office. Applicants expressly reserve the right to pursue prosecution of any presently excluded subject matter or claim embodiments in one or more future continuation and/or divisional application(s).

Applicants have carefully considered the points raised in the Office Action and believe that the Examiner’s concerns have been addressed as described herein, thereby placing this case into condition for allowance.

Withdrawn Rejections

Claims 1, 3-9, 11, 19, 20 and 23 were previously rejected under 35 U.S.C. § 112, second paragraph, as failing to comply with the definiteness requirement. Claims 19 and 21 were previously rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The Examiner confirmed the withdrawal of the 35 U.S.C. § 112, first paragraph, written description rejection of claim 24. Applicants gratefully acknowledge the withdrawal of these rejections.

Additionally, Applicants acknowledge the withdrawal of the finality of the previous Office Action.

New Rejections

The Office newly rejected claims 1-11 and 13-24 under 35 U.S.C. § 112 as being indefinite, rejected claim 5 under 35 U.S.C. § 112 for lacking antecedent basis, and rejected claims 13-18 under 35 U.S.C. § 112, first paragraph for lack of enablement.

Rejections Under 35 U.S.C. § 112, 1st paragraph:

The Office rejected claims 13-18 under 35 U.S.C. 112, first paragraph, as allegedly failing to meet the enablement requirement. The Office asserted that “a person of skill in the art would have to engage in undue experimentation to test which diseases can be treated by the compound encompassed in the instant claims, with no assurance of success.” (OA at page 9).

Without acquiescing to the rejection, Applicant has canceled claims 13-18, making the comments directed towards these claims moot.

Applicants expressly reserve the right to pursue prosecution of these cancelled claims in one or more future continuation and/or divisional application(s).

Rejections Under 35 U.S.C. § 112, 2nd paragraph:

Claims 1-11 and 13-24 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Each of the three specific rejections is discussed below:

(1) Claims 1-11 and 13-24 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claims 13-18 have been cancelled, and the comments directed to these claims are therefore moot. The Office asserted that the term “comprising” was unclear to the

Examiner, and could be interpreted in more than one way. Applicants have amended claim 1 to clarify that the claim is directed to “N-methyl-N-[(1S)-1-phenyl-2-((3S)-3-hydroxy-pyrrolidin-1-yl)ethyl]-2,2-diphenylacetamide covalently bonded to at least one acid . . .” Applicants believe that this amendment clarifies the scope of the claims, and appreciates the Examiner’s suggestion in this regard. In view of the amendments, Applicants submit that the indefiniteness rejections should be withdrawn.

(2) Claim 5 was rejected under 35 U.S.C § 112, second paragraph, as being indefinite for reciting the phrase “derivative” which lacks antecedent basis. Applicants have amended this claim to remove the offending term, and submit that the in view of the amendment, the indefiniteness rejection should be withdrawn.

(3) Claim 23 was rejected under 35 U.S.C § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner stated that it is unclear what the phrase “R¹ contains one or more functional groups in addition to the groups in addition to the group L², a derivative of R¹, which is provided fully or partly with protecting groups” means. Applicants have amended the claim to clarify this phrase. The claim now states that “if R¹ further comprises one or more functional groups selected from hydroxyl groups and acid groups, the functional group is optionally protected by a protecting group.” The phrase no longer includes the term “derivative”, and clearly defines a “functional group”. Applicants submit that in light of the specification, one of ordinary skill would understand the metes and bounds of the claims. In view of the amendments, Applicants submit that the indefiniteness rejection should be withdrawn.

CONCLUSIONS

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket No. 613242000800. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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